

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Andreas KUBIN

Hans Günther LOEW

U.S. Appl. No.: 10/527,016

PCT Appl. No. PCT/AT01/00159

Intl. Filing Date: May 21, 2001

For: PREPARATION OF HYPERICIN
BONDED WITH POLY-N-VINYLAMIDES

Group Art Unit: Unknown

Examiner: Unknown

Atty. Dkt. No.: SONN:067US

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20 SEP 2005
Legal Staff
International Division

EXPRESS MAIL MAILING LABEL

NUMBER EV 414839881 US

DATE OF DEPOSIT September 8, 2005

**REQUEST FOR RECONSIDERATION OF PETITION FOR REVIVAL OF AN
INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S.
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(B) FILED MARCH 7, 2005**

Mail Stop PCT

Commissioner for Patents

Office of PCT Legal Administration

P. O. Box 1450

Alexandria, VA 22313-1450

Commissioner:

On March 7, 2005, Applicants filed a Petition for Revival of an International Application for Patent Designating the United States Abandoned Unintentionally under 37 C.F.R. § 1.137(b) in the above-referenced international application (the "Petition"). On August 10, 2005, the Office mailed a Decision dismissing the Petition (the "Decision" - Appendix B) due to the fact that the required statement concerning the unintentional nature of the entire delay contained in Applicant's Declaration in Support of the Petition was signed by only one of the

09/30/2005 CSMOOT 00000003 501212 10527016
Sale Ref: 00000004 ADH: 001212 10527016
01 FC:1464 130.00 DA

joint inventors (Andreas Kubin) and that there was no such statement made by the other joint inventor (Hans Günther Loew). The Decision indicates that Applicants complied with all other requirements for revival of the above-referenced international application, including payment of the basic national fee (which was charged to Applicants' representative's deposit account), a statement that no terminal disclaimer was required since the international application was filed after June 8, 1995, and payment of the \$750.00 petition fee. The Decision further notes that the Declaration of the inventors filed on March 7, 2005, does not comply with 37 C.F.R. § 1.497(a) and (b) because it was not signed by joint inventor Hans Günther Loew.

In order to satisfy the missing requirement, the Decision states that counsel must furnish either a statement from Mr. Loew or his duly appointed representative that the delay was in fact unintentional, or else a power of attorney executed by Mr. Loew in favor of present counsel. Applicants submit herewith a newly executed Declaration in Support of Petition for Revival of an International Application Designating the United States Abandoned Unintentionally under 37 C.F.R. § 1.137(b), which has been signed by **both** joint inventors (Appendix C). In addition, Applicants submit a newly executed Combined Declaration and Power of Attorney which has been signed by **both** joint inventors (Appendix D). Please note that both documents have been modified to specify the serial number and to strike the indication that the application was filed "Concurrently Herewith". These non-substantive modifications were made only to assist the Office in matching the papers to the file and were made, as noted on the documents, by Mark B. Wilson, Reg. No. 37,259, who is an attorney with the firm of Fulbright & Jaworski L.L.P. and a duly appointed representative of **both** inventors, as set forth in the Combined Declaration and Power of Attorney.

Applicants believe that they have now met all the requirements for revival of the above-referenced international application, and such favorable action is respectfully requested.

It is believed that no additional fee is due at this time; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/SONN:067US.

Respectfully submitted,



Mark B. Wilson
Reg. No. 37,259
Attorney for Applicant

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
512.536.3035 (voice)
512.536.4598 (fax)

Date: September 8, 2005

APPENDIX A

**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**Docket Number
(Optional)
SONN:067US

First Named Inventor: Andreas KUBIN

International (PCT) Application No.: PCT/AT01/00159

U.S. Application No.:
(if known)

Filed: 21 May 2001

Title: Novel Preparation of Hypericin Bonded with Poly-N-Vinylamides

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee
- (2) Proper reply
- (3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee☒ Small entity - fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status.
See 37 CFR 1.27.☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))**2. Proper reply****A. The proper reply (the missing 35 U.S.C. 371(c) requirement(s)) in the form of**Transmittal to United States Designated/Elected Office Concerning a Filing (Identify type of reply):
under 37 U.S.C. 371; record copy of International Appl. No. PCT/AT01/00159☐ has been filed previously on _____☒ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

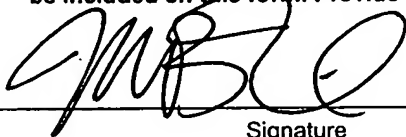
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- ☒ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.



Signature

March 7, 2005

Date

Mark B. Wilson

Typed or Printed Name

37,259

Registration Number, if applicable

600 Congress Avenue, Suite 2400

Address

512-536-3035

Telephone Number

Austin, TX 78701

Address

- Enclosures: ☒ Response
☒ Fee Payment
☐ Terminal Disclaimer
☒ Other (please identify):

Declaration in Support of Petition for Revival of an International Application Designating the United States
Abandoned Unintentionally under 37 C.F.R. 1.137(b); return postcard

EXPRESS MAIL NO: EV 414839731 US
MAILING DATE: March 7, 2005

APPENDIX B



16 AUG 2005

United States Patent and Trademark Office

FULBRIGHT & JAWORSKI, LLP

PT DOCKETING

Docketed ☒ Nat'l Req'd ☐ Confirmation ☐

Initials 1st *EF* Initials 2nd *HM*

AUG 22 2005

rec'd pm 8/24/05

Attorney

Docket No.

Action Req'd

Date Due

MBW
SONN:067US

Noted

COMMUNICATION

2mo. initial deadline 10/16/05
Final 2/16/06.

Fulbright & Jaworski, L.L.P.
600 Congress Avenue
Suite 2400
Austin, TX 78701

In re Application of
Kubin et al.
Application No. 10/527,016
PCT No.: PCT/AT01/00159
Int. Filing Date: 21 May 2001
Priority Date: 23 May 2000
Atty. Docket No.: SONN:067US
For: Novel Preparation Of Hypericin
Bonded With Poly-N-Vinylamides

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

This is in response to the petition under 37 CFR 1.137(b) filed on 07 March 2005.

BACKGROUND

This international application was filed on 21 May 2001, claimed an earlier priority date of 23 May 2000, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 29 November 2001. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. The 30 month time period for paying the basic national fee in the United States expired at midnight on 23 November 2002. This international application became abandoned with respect to the national stage in the United States under 35 U.S.C. 371 for failure to timely pay the basic national fee.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the required reply in the form of the \$150.00 basic national fee is being charged to counsel's Deposit Account No. 50-1212, as authorized by the "Preliminary Amendment" filed on 07 March 2005.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes a statement that "The entire delay from November 23, 2002, until the filing of the Petition Under 37 C.F.R. § 1.137(b) and United States application filed pursuant to 35 U.S.C. §371(c) submitted herewith was unintentional, for the

reasons set forth below." However, the petition and the statements contained within it were made only by one of the joint inventors (Andreas Kubin) and his representative. There is no statement by either the other joint inventor (Hans Gunther Loew) or a representative of Mr. Loew as to whether Mr. Loew's actions constitute "unintentional delay" during the period from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b). Counsel must furnish either a statement from Mr. Loew or his duly appointed representative that the delay was in fact unintentional, or else a power of attorney executed by Mr. Loew in favor of present counsel. For these reasons, requirement (3) has not been satisfied.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

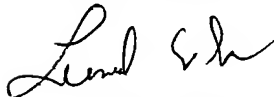
It is noted that the declaration of the inventors filed on 07 March 2005 does not comply with 37 CFR 1.497(a) and (b) because it is not signed by joint inventor Hans Gunther Loew.

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

APPENDIX C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Andres KUBIN

Hans Günther LOEW

10/527,016 by M.B.W.-L
Serial No.: To be assigned Mark B. Wilson
Reg. No. 37,259
Filed: Concurrently Herewith September 8, 2005

Group Art Unit: Unknown

Examiner: Unknown

Atty. Dkt. No.: SONN:067US

For: PREPARATION OF HYPERICIN
BONDED WITH POLY-N-VINYLAMIDES

<u>EXPRESS MAIL MAILING LABEL</u>	
NUMBER	EV 414839881 US
DATE OF DEPOSIT	September 8, 2005

**DECLARATION IN SUPPORT OF PETITION FOR REVIVAL OF AN
INTERNATIONAL APPLICATION DESIGNATING THE UNITED STATES
ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)**

We, the undersigned, Andreas Kubin and Hans Günther Loew, hereby declare as follows:

1. We are the co-inventors of the subject matter claimed in the above-captioned application.
2. We are both citizens of Austria.
3. We are providing this Declaration in support of a petition for revival of PCT/AT2001/00159 to allow for the filing of a United States nationalization of this PCT application, pursuant to the rules of 35 U.S.C. §371(c).
4. PCT/AT2001/00159 was filed May 21, 2001, and claims priority to Austrian patent application A 896/2000, filed May 23, 2000. As such, we now understand that the deadline for nationalizing PCT/AT2001/00159 into the United States was November 23, 2002.

5. The entire delay from November 23, 2002, until the filing of the Petition Under 37 C.F.R. §1.137(b) and United States application filed pursuant to 35 U.S.C. §371(c) submitted herewith was unintentional, for the reasons set forth below.

6. We are individual inventors of the instant application, who were managing the prosecution of the Austrian, PCT, and national counterpart applications on our own behalf.

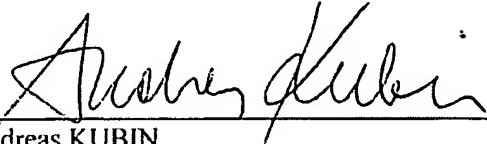
7. Prior to the time when national applications were to be filed, we divided between the two of us the geographical responsibility for filing, prosecuting, and maintaining patents for the subject matter of the instant application. In this regard, each of us undertook the financial and administrative responsibilities for various jurisdictions. During the course of this division of responsibilities, we both mistakenly understood that the other was to take responsibility for the nationalization of PCT/AT2001/00159 in the United States. Further, because each of us thought that the other was handling the United States nationalization, neither of us attended to, nor hired counsel to attend to, the filing of such an application. At all times we intended for the application to be nationalized into the United States

8. Because each of us thought that the other was responsible for the filing of the United States nationalization of the PCT application, such nationalization did not occur by the November 23, 2002, deadline. We only very recently discovered that such a nationalization had not been filed. Upon discovery of this fact, Andreas Kubin consulted with his counsel in Austria who contacted United States patent counsel and instructed the United States counsel to immediately begin the process of reviving PCT/AT2001/00159 and filing a United States nationalization of that application.

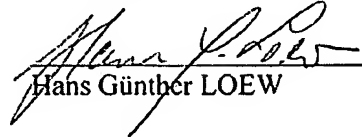
9. We declare that all statements made of our knowledge are true and all statements made on information are believed to be true; and, further that these statements were made with

the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issued thereupon.

Date: 5th Sept. '05


Andreas KUBIN

Date: 5th Sept. '05


Hans Günther LOEW

APPENDIX D

PATENT
CUSTOMER NO: 32425

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Andreas KUBIN

Hans Günther LOEW

10/527,016

Serial No.: ~~To be assigned~~

Filed: ~~Concurrently Herewith~~

For: PREPARATION OF HYPERICIN
BONDED WITH POLY-N-VINYLAMIDES

Group Art Unit: Unknown

Examiner: Unknown

Atty. Dkt. No.: SONN:067US

by Mark B. Wilson
Reg. No. 37,259
September 8, 2005

COMBINED DECLARATION AND POWER OF ATTORNEY

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or the below named inventors are the original, first and joint inventors (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **PREPARATION OF HYPERICIN BONDED WITH POLY-N-VINYLAMIDES**, the Specification of which:

- ☒ is attached hereto.
☐ was filed on _____ as Application Serial No. _____

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims.

I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability of the subject matter claimed in this application, as "materiality" is defined in Title 37, Code of Federal Regulations, § 1.56.

I hereby claim priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent, United States provisional application(s), or inventor's certificate listed below and have also identified below any foreign application for patent, United States provisional application, or inventor's certificate having a filing date before that of the application on which priority is claimed:

PRIORITY APPLICATION(S)			Priority Claimed
A. 896/2000	Austria	May 23, 2000	YES
(Number)	(Country)	(Date Filed)	Yes/No
(Number)	(Country)	(Date Filed)	Yes/No

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below or any PCT international application(s) designating the United States listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application or PCT international application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose all information known to me to be material to patentability of the subject matter claimed in this application, as "materiality" is defined in Title 37, Code of Federal Regulations, § 1.56, which become available between the filing date of the prior application and the national or PCT international filing date of this application:

PCT/AT01/00159	May 21, 2001	Nationalized
(Application Serial No.)	(Filing Date)	(Status)
(Application Serial No.)	(Filing Date)	(Status)

The undersigned, being inventors in the above-identified application hereby revokes any previous Powers of Attorney and appoints all attorneys or agents associated with Customer Number **32425**, each of whom is an attorney or agent with the firm of FULBRIGHT & JAWORSKI L.L.P., as its attorney or agent, for so long as they remain with such firm, with full power of substitution and revocation, to prosecute the application, to make alterations and amendments therein, to transact all business in the Patent and Trademark Office in connection therewith, and to receive any Letters Patent.

I hereby direct that all correspondence and telephone calls be addressed to Mark B. Wilson, Fulbright & Jaworski L.L.P., 600 Congress Avenue, Suite 2400, Austin, Texas 78701, (512) 474-5201.

I HEREBY DECLARE THAT ALL STATEMENTS MADE OF MY OWN KNOWLEDGE ARE TRUE AND THAT ALL STATEMENTS MADE ON INFORMATION AND BELIEF ARE BELIEVED TO BE TRUE; AND FURTHER THAT THESE STATEMENTS WERE MADE WITH THE KNOWLEDGE THAT WILLFUL FALSE STATEMENTS AND THE LIKE SO MADE ARE PUNISHABLE BY FINE OR IMPRISONMENT, OR BOTH, UNDER SECTION 1001 OF TITLE 18 OF THE UNITED STATES CODE AND THAT SUCH WILLFUL FALSE STATEMENTS MAY JEOPARDIZE THE VALIDITY OF THE APPLICATION OR ANY PATENT ISSUED THEREON.

Inventor's Full Name:	Andreas	Kubin
Inventor's Signature:	<i>Andreas Kubin</i>	
Country of Citizenship:	Austria	Date: 5 th Sept '05
Residence Address: (street, number, city, state, and/or country)	ERLGASSE 48 A-1120 WIEN, AUSTRIA	
Post Office Address: (if different from above)	/	

Inventor's Full Name:	Hans	Günther	Loew
Inventor's Signature:	<i>Hans G. Loew</i>		
Country of Citizenship:	Austria	Date:	5 th Sept. '05
Residence Address: (street, number, city, state, and/or country)	SÄULENGASSE 16 A-1090 WIEN, AUSTRIA		
Post Office Address: (if different from above)	/		